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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,972	05/20/2004	Ronald E. Lux	59591US002	8633
32692	7590	11/15/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 11/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,972

Applicant(s)

LUX, RONALD E.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 1-15 and 17-26 are pending in the application, claims 19-26 are withdrawn from consideration. Claim 16 has been cancelled.
2. Amendments to the claims, filed on September, have been entered in the above-identified application.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

4. Claims 1-18s are rejected under 35 U.S.C. 103(a) as being unpatentable over Lux (U.S. Patent No. 5,928,070) in view of Emerson et al. (U.S. Publication No. 2003/022318).

Lux discloses an abrasive article (*title*) comprising a web (*col. 5, lines 64-67*) and a binder (*col. 7, line 41*). The web comprising a multitude of substantially continuous three dimensionally undulated thermoplastic filaments autogenously bonding where they contact one another, wherein the filaments have a diameter in a range from 0.1 mm to 3 mm and the web has a coil web in a range from 0.1 to 3.0 kg/m² (*col. 5, lines 64-67 and col. 6, lines 7-26*). The thermoplastic filaments comprise at least one of polycaprolactum or poly(hexamethylene adipamide) (*col. 6, lines 57-61*). The article further comprises a quantity of particles affixed to the surface. The particles are in the range of 0.1 to 5 kg/m² and comprise at least one of slag,

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alumina, thermoplastic polymer, thermoset polymer, glass mullite, sand, rubber, pumice, topaz, garnet, corundum, silicon carbide, zirconia, ceramic, aluminum oxide, or diamond (*col. 8, lines 46-65*). The article further comprises a size coat. The binder and size coat comprise polyurethane (*col. 7, line 41 and col. 8, lines 39-44*).

Lux fails to disclose three-dimensional textured article.

Emerson discloses an abrasive article comprising a three dimensional shape with a first, second and third portion where the second and third portions are positioned at an angle of at least 45 degrees relative to the first surface (*figure 2*). The additional surface area of the three dimensional article helps sufficiently decrease surface roughness and remove the grinding marks or other small imperfections (*page 1, paragraph [0002]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make Lux's abrasive article three dimensional as taught by Emerson in order to help sufficiently decrease surface roughness and remove the grinding marks or other small imperfections.

The preamble "stair tread," "stairway" and "ladder rung" are deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments in the response filed September 5, 2006 regarding the 35 U.S.C. 103(a) over Lux in view of Emerson of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the references do not teach a stair tread cover. That stair tread covers allow water and other fluids to flow away from the surface, unlike the Lux and Emerson.

First, the limitation "stair tread covers allow water and other fluids to flow away from the surface" is not in the claims. Second, the limitation "stair tread" is merely a preamble. The preamble "stair tread," "stairway" and "ladder rung" are deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Applicant has not shown how the preamble "stair tread" structurally differentiates the claimed product from the prior art of record.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
11/13/06




**ALICIA CHEVALIER
PRIMARY EXAMINER**
